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REMARKS

Claims 1-29 are currently pending in the subject application and are presently under consideration. Amendments to the specification are found at pages 2-5. The claims are listed at pages 6-11.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

**I. Specification**

The specification has been amended in both the Related Applications section and Brief Description of the Drawings section. Thus, this objection should be withdrawn.

**II. Rejection of Claims 1-3 and 6 Under 35 U.S.C. §102(e)**

Claims 1-3 and 6 stand rejected under 35 U.S.C. §102(e) as being anticipated by Janik *et al.* (US Patent Publication 2002/0078248). Withdrawal of this rejection is respectfully submitted for at least the following reasons.

As recited in amended claim 1, Janik *et al.* fails to teach each and every element in the claimed invention.

“A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987) Emphasis added. “The identical invention must be shown in as complete detail as is contained in the...claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Examiner refers to the carrier portion of the subject invention as being the adapter module 14 of Janik *et al.* This is inconsistent with the limitations of the claimed invention, in that claim 1 recites the adapter unit *comprising* the carrier portion.

Moreover, even if using the Examiner’s analysis that the adapter module 14 is the carrier portion, it does not follow that the adapter module of Janik *et al.* has a cover such

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that "...the cover is secured to the bottom section of the bottom wall of the carrier portion", as recited in claim 1.

Thus, this rejection should be withdrawn for claim 1, and claims 2-3, and 6 that depend therefrom.

### III. Rejection of Claims 4-5 Under 35 U.S.C. §103(a)

Claims 4-5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Janik *et al.* in view of Herrod *et al.* (US 6,405,049). This rejection should be withdrawn for at least the following reasons.

Neither Janik *et al.* nor Herrod *et al.*, alone or in combination, teach or suggest applicants' invention as recited in the subject claims.

"It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." *Arkie Lures Inc. v. Gene Larew Tackle Inc.*, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997) (emphasis added). Moreover, that such elements may have co-existed individually for an extended period of time, but never combined in the manner claimed actually supports a conclusion of non-obviousness. *Id.*

Herrod *et al.* teaches a portable terminal with a display, data pen, audio speaker, and CCD imager (col. 9, lines 25-59). In a retail environment, a customer withdraws the portable terminal from a cradle to use for shopping (col. 10, lines 28-31). Herrod *et al.* does not teach a scanner in an *adapter unit*.

Moreover, with respect to claim 1, and from which claim 4 depends, neither Janik *et al.* nor Herrod *et al.*, alone or in combination, teach or suggest applicants' invention as an "*adapter unit* that comprises a *carrier portion*...having a *cover*..." in the manner claimed, and furthermore, "...wherein *said product identification reader is a CCD imager*."

The same argument applies to dependent claim 5 for the wireless wide area network.

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Therefore, it would not have been obvious to one skilled in the art to incorporate the teachings of Janik *et al.* and Herrod *et al.*, and it is respectfully requested that this rejection be withdrawn.

#### **IV. Rejection of Claims 7-24 Under 35 U.S.C. §103(a)**

Claims 7-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Janik *et al.* in view of Carlson (Des. 426,549; cited by the Applicants). Applicants' representative respectfully requests this rejection should be withdrawn for at least the following reasons.

Neither Janik *et al.* nor Carlson, alone or in combination, teach or suggest applicants' invention as recited in the claim 7.

Claim 7, as amended, recites in part that "...two sidewalls are configured to prevent side-to-side movement of the personal data assistant relative to the adapter unit...said gripping surface radiates in an outward direction relative to a vertical axis *perpendicular to said bottom wall*. The "gripping surface" referenced by the Examiner in the illustrations of Carlson does not radiate outward from such an axis as recited in claim 7. Thus, Carlson fails to make up for the deficiencies of Janik *et al.*

Moreover, contrary to the Examiner's statement, Janik *et al.* does not teach or suggest two sidewalls configured to prevent side-to-side movement of the personal data assistant relative to the adapter unit. Neither the adapter unit nor the docking cradle of Janik *et al.* have such sidewalls.

Furthermore, there is no motivation to combine the "gripping surface(s)" of the accessory of Carlson with the adapter module of Janik *et al.* as they are incompatible and would involve significant modifications to both the adapter module and the PDA of Janik *et al.*, in that the adapter module of Janik *et al.* utilizes a latch hook 34 to secure the PDA. Thus, it would not have been obvious to incorporate the teachings of Carlson with Janik *et al.* to meet the claimed limitations. The arguments put forth with respect to claim 1 also apply.

It is requested that this rejection be withdrawn for independent claim 7 and claims 8-14 that depend therefrom.

Neither Janik *et al.* nor Carlson, alone or in combination, teach or suggest applicants'

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invention as recited in the claim 15.

Claim 15 recites in part "...two sidewalls are configured to prevent side-to-side movement of the personal data assistant relative to the adapter unit". Janik *et al.* does not teach or suggest two sidewalls configured to prevent side-to-side movement of the personal data assistant relative to the adapter unit, since neither the adapter unit nor docking cradle of Janik *et al.* have such sidewalls. Again, there is no motivation to combine the "gripping surface" of Carlson with the adapter module of Janik *et al.* as this would involve significant modifications to both the adapter module and the PDA of Janik *et al.*, in that Janik *et al.* utilizes a latch hook 34 to secure the PDA with the adapter module. The arguments submitted with respect to claim 1 also apply. Thus, it would not have been obvious to incorporate the teachings of Carlson with Janik *et al.* to meet the claimed limitations.

These arguments also apply to independent claim 20. Thus, it is requested that this rejection be withdrawn for independent claims 15 and 20, and respective dependent claims 16-19 and 21-24.

#### **V. Rejection of Claims 25-29 Under 35 U.S.C. §103(a)**

Claims 25-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Janik *et al.* in view of Whitridge *et al.* (US 6,119,179). This rejection should be withdrawn for at least the following reasons.

Neither Janik *et al.* nor Whitridge *et al.*, alone or in combination, teach or suggest applicants' invention as recited in the claim 25.

Janik *et al.* does not teach or suggest two sidewalls configured to prevent side-to-side and vertical movement of the personal data assistant relative to the adapter unit, since neither the adapter unit nor docking cradle of Janik *et al.* have such sidewalls, and Whitridge *et al.* does not make up for its deficiencies. The arguments put forth with respect to claim 1 also apply.

Furthermore, there is no motivation to combine the clip of Whitridge *et al.* with the adapter module of Janik *et al.*, since the adapter module of Janik *et al.* already includes a latch hook to secure the PDA to the adapter module. Thus, it would not have been obvious to incorporate the teachings of Whitridge *et al.* with Janik *et al.* to meet the claimed limitations.

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Even if Janik *et al.* and Whitridge *et al.* were combinable, they would defeat the purposes of the claimed invention. The clip of Whitridge *et al.* employed in place of the claimed retainer clip would block usage of the scanning device of the subject invention.

Therefore it is requested that this rejection be withdrawn for independent claim 25 and claims 26-29 that depend therefrom.

**VI. CONCLUSION**

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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